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James H. Murray

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAMES H. MURRAY  
and NEAL FAIRBANKS

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Appeal 2009-005131  
Application 10/605,684  
Technology Center 2100

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Decided: March 19, 2010

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Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and  
THU A. DANG, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-39, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

*Representative Claim*

1. A method of retrieving information (10) associated with an object (12) present in a media stream (14), said method comprising the steps of:

defining a user-selectable region (18) in a layer (20) separate from the media stream (14) and without accessing individual frames of the media stream (14), the user-selectable region (18) tracking a position of the object (12) present in the media stream (14);

defining a link (34) to the information (10) associated with the object (12);

linking the user-selectable region (18) in the layer (20) to the link (34) for the information (10) associated with the object (12);

positioning the user-selectable region (18) in the layer (20) over the object (12) such that the user-selectable region (18) tracks the position of the object (12) during playback of the media stream (14);

disposing the layer (20) adjacent the media stream (14) without interfering with playback of the media stream (14);

playing the media stream (14) in a player;

selecting the user-selectable region (18) from within the layer (20) during playback of the media stream (14); and

accessing the information (10) associated with the object (12) in response to selecting the user-selectable region (18) from within the layer (20).

### *Publications*

Wink Communications archived Web pages from wink.com (identified as pages 1-13), retrieved from Internet Archive Wayback Machine, <http://web.archive.org> (“Wink I”).

V. Michael Bove, Jr. et al., *Adding Hyperlinks to Digital Television*, Proc. 140th SMPTE Technical Conference (1998) (“Bove”).

Interactive TV Today, *Intellocity & Wink Communications* (2003), [http://itvt.com/screenShotGallery/Intellocity\\_&\\_Wink\\_Communications/page1.html](http://itvt.com/screenShotGallery/Intellocity_&_Wink_Communications/page1.html) (“Wink II”).

### *Examiner’s Rejections*

Claims 1-13, 15-33, and 35-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wink I and Bove.

Claims 14 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wink I, Bove, and Wink II.

## DISCUSSION

### *Prior Art*

Initially, we note that Appellants contend that neither of Wink I or Wink II have been established as prior art.

Wink I appears to consist of archived copies of pages from a “wink.com” Web site, retrieved from the Web site “archive.org.” Based on the Uniform Resource Locator (URL) content at the bottom of each page, pages 1 through 4 and 11 through 13 appear to represent Web pages that were published (publicly available) on the “wink.com” site in the year 1999. Pages 5 through 10 appear to represent Web pages that were published

during months in the year 2000. The file copy of Wink I was apparently printed on August 30, 2006.

The instant application has a filing date of October 17, 2003. Appellants submit (Br. 17) that the application was filed as a “continuation-in-part” of an earlier application, and has an “effective filing date” of July 31, 2000. However, Appellants address “Wink I” as having a publication date in the “1999 time frame” (*id.*) More important, however, Appellants do not show (or even allege) which, if any, of the 39 claims on appeal may be supported (35 U.S.C. § 112, first paragraph) by the earlier application and thus entitled to an effective filing date of July 31, 2000. *See* 35 U.S.C. § 120 (entitles benefit of earlier filing “for an invention disclosed in the manner provided by the first paragraph of section 112” in an earlier filed application).

With respect to the prior art status of Wink I in the context of demonstrating *prima facie* unpatentability, we note that the rules of evidence are somewhat relaxed in the instant *ex parte* proceedings. For example, hearsay statements in a document that is not “prior art” may be relied upon to establish facts necessary to support a rejection in *ex parte* examination. *See In re Epstein*, 32 F.3d 1559, 1567 (Fed. Cir. 1994) (court assumed the truthfulness of various assertions in abstracts that were not “prior art” publications as to appellant, because the assertions appeared on their face to be accurate and reliable, and because appellant failed to proffer any evidence to support arguments to the contrary).

Appellants submit there “has been much discussion about the impropriety of relying upon such dating methods as there are concerns that the content and dates can be circumvented.” (Br. 16-17.) Appellants do not,

however, provide evidence of such “discussions” or where they may be found. More important, Appellants have not provided any evidence to show that the Web site from which Wink I was retrieved is not reliable as to presumed dates of publication. Nor have Appellants provided any other evidence tending to show that the content described by Wink I was not publicly available on the presumed dates.

On this record, we conclude that the Examiner properly considered Wink I to represent prior art with respect to the invention(s) of the rejected claim(s).

Wink II appears to have been printed (Aug. 29, 2006) from a Web site representing a different source from Wink I -- i.e., neither from “archive.org” nor “wink.com.” The last (third) page of Wink II contains a copyright notice dated “1998-2003.” Because the notice suggests that the content of the underlying document (Web pages) may have been modified at any time until the end of 2003, we cannot say that Wink II predates the instant application filing date of October 17, 2003.

Based on the statement of rejection applied against claims 14 and 34 (Ans. 21), and the Examiner’s responsive arguments (*id.* at 26-27), the Examiner does not appear to allege any particular publication date for Wink II. The rejection appears to rely on Wink II as further description of the “same system” described by Wink I. However, the rejection does not point to any evidence in support of the contention. Based on the apparent dates of the underlying Web pages, Wink II could represent content that included later refinements of the “system” described by Wink I, rather than the “same system.” In any event, the rejection does not provide a sufficient basis for

considering Wink II as representing prior art with respect to the invention of claim 14 or claim 34.

*§ 103(a) Rejections*

Because we agree with Appellants that the content of Wink II has not been established as prior art, the § 103(a) rejection of dependent claims 14 and 34 could be reversed on that basis alone. However, we do not sustain the applied § 103(a) rejections for the reasons that follow.

A determination of obviousness under 35 U.S.C. § 103 is a legal conclusion involving factual inquiries. If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. *In re Hedges*, 783 F.2d 1038, 1039 (Fed. Cir. 1986) (citing *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984)). Patentability is determined on the totality of the record, by a preponderance of evidence standard. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The record requires support for the conclusion -- support by specific findings that address an appellant's proffered evidence -- that the evidence of obviousness is believed to outweigh the evidence of non-obviousness.

In this case, Appellants' Appeal Brief relies on an expert's declaration (37 C.F.R. § 1.132) in the attached Evidence Appendix. According to Appellants, the declaration demonstrates that the proposed combination of references would not yield an operable combination, identifies the presence of indicia that "teach away" from the combination, identifies why such a combination would be undesirable, identifies why such a combination is not

obvious, and that even if such a combination were made, the combination would not meet limitations contained in each of the independent claims. Br. 9-10 (citing paragraphs 34-39 of the declaration).

We observe that paragraphs 34 through 39 of the declaration contain conclusions, but are preceded by facts alleged with respect to “prior technologies” (¶¶ 16-19) and in particular the “cited references” (¶¶ 20-33).

The Examiner responds:

After careful consideration of the Declaration and the submitted prior art relied upon and the Applicants arguments the Examiner is not persuaded and believes it would have been obvious to one of ordinary skill in the art to combine Bove into Wink and furthermore the combination of Wink and Bove teach each limitation relied upon in the previous office action especially the two limitations pointed out in the remarks section of the amendment provided by the application on pages 12-13. (Also note A1 above).

Ans. 26.

The evaluation of Appellants’ declaration on this record thus consists of the words “the Examiner is not persuaded.”

Although the Examiner is not persuaded, the Examiner has not told us why. In particular, the Examiner has not addressed the content of the declaration and provided reasons why all (or any) of Appellants’ allegations in support of patentability might be not supported by the evidence or are otherwise invalid. Without the Examiner setting forth specific findings directed to the content of, and the weight to be afforded, the proffered evidence, this merits panel is not in a position to sustain the § 103 rejections. The Board serves as a board of review, and does not perform examination in the first instance. *See* 35 U.S.C. § 6(b).



Appeal 2009-005131  
Application 10/605,684

DECISION

The rejection of claims 1-13, 15-33, and 35-39 under 35 U.S.C. § 103(a) as being unpatentable over Wink I and Bove is reversed.

The rejection of claims 14 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Wink I, Bove, and Wink II is reversed.

REVERSED

msc

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